REMARKS

This response is intended as a full and complete response to the final Office Action mailed March 11, 2005. In the Office Action, the Examiner notes that claims 1-7, 9-45 and 51-58 are pending and rejected. By this response, no amendments were made to the claims.

In view of the following discussion, the Applicants submit that none of the claims now pending in the application are anticipated or obvious under the respective provisions of 35 U.S.C. §102 and 103. Further, the Applicants have addressed the Examiner's Double Patenting Rejections and submits that none of the claims are double patented under the statutory type of double patenting rejection, and that a terminal disclaimer will be filed for those claims being rejected for the judicially created doctrine of double patenting. Thus, the Applicants believe that all of these claims are now in allowable form.

It is to be understood that the Applicants do not acquiesce to the Examiner's characterizations of the art of record or to the Applicants' subject matter recited in the pending claims. Further, the Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant responsive reply.

REJECTIONS

Double Patenting

Obviousness Double Patenting

The Examiner has rejected claims 1, 6, 32, 42, 51, and 54 provisionally under the judicially created doctrine of obviousness-type double patenting as being unpatentable over, respectively, claims 1, 7, 34, 43, 51 and 54 of copending Application Serial No. 09/628,805.

In response, the Applicants will file a Terminal Disclaimer in the copending Application Serial No. 09/628,805 under 37 C.F.R. 1.130(b) upon indication of allowable subject matter. As such, the Applicant respectfully request that the obviousness-type double patenting rejection be held in abeyance.

35 U.S.C. §103

Claims 1-7, 9-45 and 51-58

The Examiner has rejected claims 1-7, 9-45 and 51-58 as being obvious and unpatentable under the provisions of 35 U.S.C. §103(a). In particular, the Examiner has rejected claims 1-7, 9-45 and 51-58 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 6,177,931 to Alexander (hereinafter "Alexander") in view of of U.S. Patent 6,493,872 to Rangan (hereinafter "Rangan"). The Applicants respectfully traverse the rejection.

Applicants' independent claims 1, 6, 26 and 52 recite different aspects of the present invention including the limitation for the terminal assigning targeted virtual objects to virtual object location in a video program. Specifically, claim 1 includes the limitation of "instruct terminals to select one of the one or more virtual objects for placement at said at least one virtual advertisement spot in a video program." Claim 6 includes the limitations of "the terminal designates which of the one or more virtual object locations displays an alternate virtual object in said video program." Claim 26 includes the limitation "providing the retrieval plan to one or more of the terminals; and providing a video program to one or more of the terminals, the video program including at least one virtual object location." Claim 52 includes the limitation of "instructs viewers' terminals to insert one or more of the virtual objects into one or more of the virtual objects in the video program." As shown by the claims and the disclosure of the present invention the invention includes system and method of the terminal selectively assigning virtual objects to the video programs containing virtual object locations.

According to MPEP 2143.03, all claim limitations must be taught or suggested. "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). 'All words in a claim must be considered in judging the patentability of that claim against the prior art.' In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). "

Neither references disclose selectively assigning virtual objects at the terminal in video program containing virtual objects locations. Alexander teaches an electronic programming guide (EPG) that provides improved user interaction. In particular, it

discloses having virtual channel ad displayed on the tiles of the electronic program guide. It does not disclose, teach or suggest that these virtual channel ads could be placed in a virtual object location within a video program at the terminal. Moreover, Alexander does not even teach or suggest virtual objects in video programs. Rangan discloses synchronizing data streams to be displayed at an end station. Specifically, Rangan uses an authoring server to replace a selected entity of the program and create an annotation stream. One data stream is a live video stream and the other is an annotation stream having added material to be displayed with the live video stream. The annotation stream includes tracking data derived from tracking an entity in the first data stream. Using then combines that replacement with the original data stream (See Rangan, Fig. 9, column 16, lines 56-67). It does not disclose, teach or suggest video programming containing virtual object locations for selectively placing virtual objects at a terminal, such as using a retrieval plan. Thus, both references lack any teaching or suggestion that a virtual object could be selectively assigned in a video at the terminal (emphasis added).

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 USPQ 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 USPQ 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added). The Alexander and Rangan references alone and in combination fail to teach or suggest the Applicants' invention as a whole.

Alexander failed to disclose virtual object could be selectively assigned in a virtual location in a video at the terminal. Furthermore, the Rangan reference does not bridge the substantial gap between the Alexander reference and the Applicant's invention. Rangan also does not disclose teach or suggest virtual object could be selectively assigned in a virtual location in a video at the terminal.

In addition, there is no motivation to combine Alexander and Rangan. According to MPEP 2143.01: THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION. Therefore, the prior art as a whole must "suggest the

desirability" of the combination. Neither reference suggested the desirability of having terminals with interactive virtual object location in the video wherein virtual objects would be selectively placed in those locations. Alexander, Rangan and the present invention are trying to solve completely different problems. Alexander realized that earlier Electronic Programming Guides (EPG) has extremely limited viewer interaction capabilities. Alexander wanted to improve over the previous EPG by allowing for improved viewer interactions including utilization of viewer profile information to provide customized presentation of advertising to the viewer. Rangan, on the other hand, is solving a completely unrelated problem. Rangan realized there a need for users of data network to receive and resynchronize separate data streams from separate and unrelated delivery systems. The problem Rangan is trying to solve is latency because different networks have unpredictable delays sending different data stream over different networks provide a formidable challenge to resynchronize them and display as one stream to the user. Rangan states that such solution could allow for personalization of advertising for target end users. Even those both of these references involves advertisements, the natures of the problem they are trying to solve are completely different and unrelated from each other and from the present invention. Improving the EPG by make it more interactive is completely unrelated to synchronization of different data streams. Therefore, there is no motivation to combine because the nature of the problem for Alexander is different than the nature of the problem for Rangan and neither suggests a desire to combine to form the present invention. Alexander does not teach or suggest the personalizing advertising in video using virtual objects at the terminals. Furthermore, Alexander teaches away from that idea of having advertisements in videos because it teaches having static advertisement boxes on the EPG separate from the unedited video displayed in another box. Moreover, Rangan does not even consider the possibility of having virtual object locations where the terminal device may selectively place virtual objects. None of the references teach or suggest the desirability of personalizing advertising in video using virtual objects at the terminals.

Even if the two references could somehow be operably combined, the combination would provide a library of advertisements stored at the viewer's terminal

where the EPG selects advertisements for display according to pre-established selection criteria, and an authoring station for tracking and inserting advertisements in a video stream that is upstream from the user's terminal. Nowhere in the combined references is there any teaching or suggestion of "generating a retrieval plan at one or more viewer's terminals, wherein a retrieval plan at the terminal designates which of the one or more virtual object locations displays an alternate virtual object in said video program." Therefore, the combined references fail to teach or suggest the Applicant's invention as a whole.

Furthermore, the Examiner's Official Notice is limited to teaching that the use of a PC as a terminal is well-known in the art. Even if the Alexander and Rangan references and the Examiner's Official Notice could somehow be operably combined, the combination would disclose customizing an overlay message to an advertisement in an EPG and sending the customized messages from a head end to the viewer's terminal for use when the advertisement runs. Nowhere in the combined references is there any teaching or suggestion of "generating a retrieval plan at one or more viewer's terminals, wherein the retrieval plan designates which of the one or more virtual object locations displays an alternate virtual object in said video program." Therefore, the combined references fail to teach or suggest the Applicant's invention as a whole.

As such, the Applicants submit that independent claims 1, 6, 26, 32, 42, 51, 52, 53 and 54 and dependent claims 2-5, 7, 9-25, 27-31, 33-41, 43-45, and 55-58 which depend directly or indirectly from independent claims 1, 6, 26, 32, 42 51, 52, 53 and 54 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, the Applicants respectfully request that the Examiner's rejection be withdrawn.

CONCLUSION

Thus, the Applicants submit that none of the claims presently in the application are anticipated or obvious under the respective provisions of 35 U.S.C. §102 and §103. The Applicant further submits that Applicant has addressed the Examiner's double patenting rejections and they should be withdrawn. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

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